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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,532	09/14/2000	Jodi A. Dalvey	946.011US1	8732

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT	PAPER NUMBER
1774	19

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicant No.	Applicant(s)
	09/661,532	DALVEY ET AL.
	Examiner	Art Unit
	Michael E. Grendzynski	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 April 2003.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-5,10,11 and 13-20 is/are pending in the application.

4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3-5,10,11, and 14-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                            4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                    6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Group I, species "a" in Paper Nos. 9 & 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Objections***

2. Claim 5 is objected to because of the following informalities: it is a duplicate of claim 4. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-5, 10, 11, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams (US 2001/0051265). Applicants claim an image sheet comprising, in order, (1) a base layer; (2) a release layer; (3) an adhesive layer effective for transferring the image to a fibrous substrate without the application of heat consisting of one or more PSA adhesives, water-activated adhesives, UV-cured adhesives, electro-beam cured adhesives, or other pressure sensitive adhesives; (4) an image-imparting polymer layer comprising an ethylene copolymer; and (5) an ink imaged primer layer. Williams discloses a heat-setting label sheet comprising (1) a support; (2) a PSA layer; (3) an adhesion layer; and (4) an

image-receiving layer. *See* ¶ 187 and FIG. 1. The support is equivalent to applicants base layer with a release layer thereon—it comprises a silicone-coated paper. *See* ¶¶ 25 & 26. The PSA layer is equivalent to applicants' adhesive layer—it contains a PSA adhesive. With regard to the claimed image transfer properties, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. MPEP § 2112.01. “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *Id.* (citing *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. MPEP § 2112.01. To date, this burden has not been sustained. The adhesion layer is equivalent to applicants' image-imparting polymer layer comprising an ethylene copolymer. It comprises an ethylene copolymer. *See* ¶ 54. The image-receiving layer is equivalent to applicants' primer layer—it comprises a layer containing an ink image. *See* ¶ 164. The limitations of the claims are met by the disclosure of the reference.

With regard to claims 3-5, Williams discloses that its adhesion layer comprises Surlyn®, which is a known ethylene-methacrylic acid copolymer.

With regard to claims 10 & 11, since the adhesion layer of Williams comprises applicants' claimed composition, it is inherent the layer possesses these properties.

With regard to claim 14, the base and adhesive layers are laminated. *See* Examples.

5. Claims 1, 10, 11, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams (US 2001/0051265). Williams discloses a heat-setting label sheet comprising (1) a support; (2) a PSA layer; (3) an adhesion layer; (4) an opaque layer and (5) an image-receiving layer. *See* ¶ 187 and FIG. 1. The support is equivalent to applicants base layer with a release layer thereon—it comprises a silicone-

coated paper. *See ¶¶ 25 & 26.* The PSA layer is equivalent to applicants' adhesive layer—it contains a PSA adhesive. With regard to the claimed image transfer properties, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. MPEP § 2112.01. "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *Id.* (citing *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. MPEP § 2112.01. To date, this burden has not been sustained. The opaque layer is equivalent to applicants' image-imparting polymer layer comprising an ethylene copolymer. It comprises an ethylene copolymer. *See ¶ 160.* The image-receiving layer is equivalent to applicants' primer layer—it comprises a layer containing an ink image. *See ¶ 164.*

With regard to claims 10 & 11, since the adhesion layer of Williams comprises applicants' claimed composition, it is inherent the layer possesses these properties.

With regard to claim 14, the base and adhesive layers are laminated. *See Examples.*

With regard to claim 15, Williams discloses that the layer comprises a coloring agent. *See ¶ 160* (disclosing white pigments).

#### ***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams, as applied to claims 1, 3-5, 10, 11, and 14, above in view of either the Photopia® or Chromicolor® Product Bulletins. While not limiting the additives that may be placed in its adhesion layer, Williams does not

specifically disclose the use of coloring agents. The addition of coloring agents to a layer is notoriously well known in the art, for it provides color to a layer, not only to provide an attractive, design appearance, but also to contrast any image placed thereon. The Photopia® Product Bulletin teaches that photochromic colorants may be added to layers of transfer papers. *See* Photopia® Product Bulletin. The Chromiccolor® Product Bulletin, moreover, teaches that thermochromic colorants may be used in transfer papers to provide images that changes color with change in temperature. *See* Chromiccolor® Product Bulletin. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a colorant responsive to UV-light such as Photopia® colorants in the Williams adhesion layer, motivated by the desire of providing “color changing excitement” to the Williams medium, as taught by the Photopia® Product Bulletin. Similarly, it would have been obvious to use a colorant responsive to temperature in the Williams transfer paper, motivated by the desire of providing an image that would change color with change in temperature, as taught by the Chromiccolor® Product Bulletin.

8. Claims 1, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams, as applied to claims 1, 10, 11, 14, and 15, above, in view of either the Photopia® or Chromiccolor® Product Bulletins. While disclosing the use of colorants, Williams, while disclosing the use of colorants in its opaque layer serves to render an image visible against a dark receptor and improves the readability an appearance of an image, does not specifically disclose the use of colorants that change color with changes in temperature or pH. *See* ¶ 153. The Photopia® Product Bulletin teaches that photochromic colorants may be added to layers of transfer papers. *See* Photopia® Product Bulletin. The Chromiccolor® Product Bulletin, moreover, teaches that thermochromic colorants may be used in transfer papers to provide images that changes color with change in temperature. *See* Chromiccolor® Product Bulletin. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a colorant responsive to UV-light such as Photopia® colorants in the Williams opaque layer, motivated by the desire of providing “color changing excitement” to the medium, as taught by the Photopia® Product Bulletin.

Similarly, it would have been obvious to use a colorant responsive to temperature in the Williams opaque layer, motivated by the desire of providing an image that would change color with change in temperature, as taught by the Chromicolor® Product Bulletin.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.

*Michael C. Grendzynski*

Michael E. Grendzynski

Assistant Examiner

May 13, 2003

*Bruce Hess*

BRUCE H. HESS  
PRIMARY EXAMINER